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09/518,625	03/03/2000	Yoshinori Murata		5929

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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/10/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/518,625

Applicant(s)

MURATA, YOSHINORI

Examiner

CHAN S PARK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Objections*

2. Claim 11 is objected to because of the following informalities: a lack of antecedent basis of word "apparatus". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 11, 12, 14, 15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al. U.S. Patent No. 6,417,935 (hereinafter Saito).

3. With respect to claim 1 the Saito reference discloses a communication terminal device (facsimile apparatus) comprising:

Document input means (contact sensor 613) for obtaining an image to be transmitted (col. 9, lines 25-27);

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Image storage means (image memory 606) for storing the image obtained by the document input means (col. 9, lines 10-11);

Communication network means (network control unit 618) capable of communicating with a recipient over a communication line (network62) or network (col. 9, lines 36-41); and

Control means (CPU 601) for causing the communication control means to initiates dialing to the recipient when at least one page worth of image has been obtained from the document input means and stored in the image storage means (col. 12, lines 4-19).

Referring to fig. 7 of the reference, specifically to the process comprising the steps 7201, 7207, 7208, and 7205, the device must store at least one page worth of image before transmitting the data to the recipient. It should be noted that *dialing* the FAX number of recipient (col. 4, lines 49-50) during the transmission task is an inherent step in the facsimile transmission task. Read the description of the transmission task in col. 11, lines 11-17.

4. With respect to claim 4, the Saito reference discloses the device further including monitoring mans (console panel control gate array 6) for enabling a user to monitor the communication line or network (network associated with the FAX number), and wherein the control means activates the monitoring means when the communication control means initiates dialing (col. 4, lines 50-64). Note that status of transmission including the completion of transmission is informed to the user by display unit 7.

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5. With respect to claim 11, the Saito reference discloses a device wherein the scanning and transmission are performed simultaneously from the second page of the document (col. 12, lines 20-36 & col. 13, lines 3-8). Note when the process comprising the steps 7201, 7207, 7208, 7205, and 7206 is conducted, the second page (next page) is read or scanned while the first page, which is not the last page, is being transmitted by the transmission task. Thus, the scanning and transmission are performed simultaneously.

6. With respect to claim 12, the Saito reference teaches a communication method comprising the steps of:

- a. Obtaining an image from a document (col. 9, lines 25-27);
- b. Storing the image obtained in step (a) in a memory (col. 9, lines 10-11);
- and
- c. Dialing to a recipient after at least one page worth of image is stored in step (b) for sending the image to the recipient over a communication line or network (col. 12, lines 4-19).

Referring to fig. 7 of the reference, specifically to the process comprising the steps 7201, 7207, 7208, and 7205, the device must store at least one page worth of image before transmitting the data to the recipient. It should be noted that *dialing* the FAX number of recipient (col. 4, lines 49-50) during the transmission task is an inherent step in the facsimile transmission task. Read the description of the transmission task in col. 11, lines 11-17.

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7. With respect to claim 14, the Saito reference teaches the communication method further including the step of monitoring the communication line or network (network associated with the FAX number in col. 4, lines 50-64). Note that status of transmission including the completion of transmission is informed to the user by display unit 7.

8. With respect to claim 15, the Saito reference teaches the communication method further including the step of including information indicating that transmission is to be continued in a further communication in the transmission image (col. 12, lines 36-47). If the last page of image data has not been stored, further reading, storing, and transmitting of image is repeated until all pages are transmitted (fig. 7).

9. With respect to claim 19, the Saito reference teaches the communication method wherein scanning and transmission are performed simultaneously starting from a second page of the document (col. 12, lines 20-36 & col. 13, lines 3-8). Note when the process comprising the steps 7201, 7207, 7208, 7205, and 7206 is conducted, the second page (next page) is read or scanned while the first page, which is not the last page, is being transmitted by the transmission task. Thus, the scanning and transmission are performed simultaneously.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito as applied to claim 1 above, and further in view of Nagaishi U.S. Patent No. 5,038,226.

10. With respect to claim 2, as noted above, the Saito reference discloses all the limitations of communication terminal device in claim 1. Additionally, it further discloses control means that detects the remaining capacity of memory and determines if the capacity falls within a predetermined value (col. 12, lines 20-36). However, the reference fails to explicitly disclose the control means that indicates an incompletely stored page number to the user.

The Nagaishi reference discloses a communication terminal device comprising:

Document input means (reading means 2) for obtaining an image to be transmitted (col. 2, lines 60-63);

Image storage means (RAM 9) for storing the image obtained by the document input means (col. 2, line 67 – col. 3, line 2);

Communication network means (net control unit 4) capable of communicating with a recipient over a communication line or network (col. 2, lines 62-66); and

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Control means (CPU 1) for causing the communication control means to transmit the image data stored in RAM to the recipient (col. 2, lines 56-59).

Furthermore, Nagaishi discloses a device that indicates on display panel (15) the number of pages for which the information has already been stored when the insufficiency of storage occurs (col. 4, line 64 – col. 5, line 6). Thus, it would evidently inform the user the incompletely stored page number so that the unprocessed or unsaved documents may be stacked again for transmission (col. 5, lines 2-3).

Saito and Nagaishi are analogous art because they are from the same field of endeavor, which is the facsimile art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the method detecting the insufficiency of predetermined remaining capacity of memory of Saito with the method of indicating the number of pages that have been saved in the memory at the time of the insufficiency of memory of Nagaishi.

The motivation for doing so would have been to notify the user to input unsaved documents to the document input means so that they can be stored and transmitted (col. 5, lines 2-6 of Nagaishi).

Therefore, it would have been obvious to combine Saito with Nagaishi to obtain the invention as specified in claim 2.

11. With respect to claim 3, arguments analogous to those presented for claim 2, are applicable. Note that the Office interprets that the word "insufficiency" of Nagaishi (col.



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4, line 64 – col. 5, line 6) also encompasses the condition when the memory becomes full.

12. With respect to claim 5, the Saito reference discloses the device further including monitoring means (console panel control gate array 6) for enabling a user to monitor the communication line or network (network associated with the FAX number), and wherein the control means activates the monitoring means when the communication control means initiates dialing (col. 4, lines 50-64). Note that status of transmission including the completion of transmission is informed to the user by display unit 7.

13. With respect to claim 6, the Saito reference discloses the device further including monitoring means (console panel control gate array 6) for enabling a user to monitor the communication line or network (network associated with the FAX number), and wherein the control means activates the monitoring means when the communication control means initiates dialing (col. 4, lines 50-64). Note that status of transmission including the completion of transmission is informed to the user by display unit 7.

14. With respect to claim 7, the Saito reference discloses the device wherein information indicating that the transmission is to be continued in a further communication is included in the transmission image (col. 12, lines 36-47). If the last page of image data has not been stored, further reading, storing, and transmitting of image is repeated until all pages are transmitted (fig. 7).

15. With respect to claim 8, the Saito reference discloses the device wherein information indicating that the transmission is to be continued in a further communication is included in the transmission image (col. 12, lines 36-47). If the last

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page of image data has not been stored, further reading, storing, and transmitting of image is repeated until all pages are transmitted (fig. 7).

16. With respect to claim 9, as noted above in claim 3, the Nagaishi reference discloses that if one page of an image cannot be stored (insufficiency of storage), the device informs the user of the fact (col. 4, line 64 – col. 5, line 6). Additionally, the Office interprets that detecting the memory capacity of Saito is done to check if one more page of data can be saved in the storage. As long next page can be stored in the memory, the page data will be saved in the memory (col. 11, lines 39-45 & col. 13, lines 9-23)

17. With respect to claim 10, the Nagaishi reference discloses the device wherein the device informs the user, the device suggests an alternative transmission method (col. 5, lines 3-6). Additionally, the Saito reference also discloses an alternative transmission method (col. 13, lines 42-64).

Claims 13, 16-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito as applied to claim 12 above, and further in view of Nagaishi.

18. With respect to claim 13, arguments analogous to those presented for claim 2, are applicable.

19. With respect to claim 16, arguments analogous to those presented for claim 7, are applicable.

20. With respect to claim 17, arguments analogous to those presented for claims 2 and 10, are applicable.

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21. With respect to claim 18, arguments analogous to those presented for claims 2 and 10, are applicable.

22. With respect to claim 20, the Saito reference teaches the communication method wherein scanning and transmission are performed simultaneously starting from a second page of the document (col. 12, lines 20-36 & col. 13, lines 3-8). Note when the process comprising the steps 7201, 7207, 7208, 7205, and 7206 is conducted, the second page (next page) is read or scanned while the first page, which is not the last page, is being transmitted by the transmission task. Thus, the scanning and transmission are performed simultaneously.

### ***Conclusion***

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 6,160,636 to Nagano et al. discloses a facsimile system that detects the amount of data stored in the memory and adjusts the speed of scanning based on the capacity of the memory. Transmission and scanning of documents occurs simultaneously.

U.S. Patent 5,801,839 to Ochiai discloses a facsimile system that detects the remaining capacity of a memory and controls the scanning means accordingly.


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24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park  
February 23, 2004

  
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